

REMARKS/ARGUMENTS

Upon entry of this Amendment, Claims 1 and 3 will be pending in the application. Claims 2 and 4 have been canceled. Non-elected Claims 5-10 have been withdrawn by the Examiner.

By the present Amendment, the specification has been amended to correctly list the continuing data of this application.

Claims 2 and 4 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. By the present Amendment, Claims 2 and 4 have been canceled, thereby obviating the 35 U.S.C. § 112 rejection.

Claims 1 and 3 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Firoozabady et al. '789. According to the Office Action Firoozabady et al. '789 teaches an ornamental plant (column 18, Table 3, and column 19, lines 23-45) that expresses luciferase (Fig. 3 and column 2, line 62 to column 3, line 16) and a plant food comprising luciferin (column 2, line 62 to column 3, line 16). Applicant submits that Claim 1, as amended, is patentable over Firoozabady et al. '789.

Claim 1, as amended, more clearly recites a combination comprising: a living transgenic plant that expresses luciferase; and plant food that comprises luciferin, wherein supply of the plant food to the living transgenic plant causes the living transgenic plant to illuminate. Basis for the amended language of Claim 1 is provided in the specification, for example, at page 132, lines 6-16. The combination recited in Claim 1 entails illumination of a living transgenic plant when plant food is supplied to the plant, e.g., by feeding the plant food to the roots of the plant or by spraying the plant food on the plant. The recited combination is not taught or suggested by the Firoozabady et al. '789.

Firoozabady et al. '789 teaches that a transformed rose embryogenic calli bearing a firefly luciferase gene may be tested for the presence of such gene by placing the calli in a solution comprising luciferin and measuring luminance generated by the assay. No teaching or suggestion is provided by Firoozabady et al. '789 that a living transgenic plant that expresses luciferase could be supplied with a plant food comprising luciferin to thereby illuminate the living transgenic plant. Accordingly, it is submitted that Claim 1, and Claim 3 that depends therefrom, are patentable over the prior art of record.

In view of the foregoing amendments and remarks, it is submitted that the application is in condition for allowance. Accordingly, an early Notice of Allowance of this application is respectfully requested.

In the event that any outstanding matters remain in connection with this application, the Examiner is invited to telephone the undersigned at (412) 263-4340 to discuss such matters.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Alan G. Towner", written in a cursive style.

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